



Docket No. BC9-99-0024

In re application of: Jennie CHING et al.

Serial No.: 09/412,969

Filed: October 5, 1999

For: *DYNAMIC COMPOSITION AT THE SET-TOP BOX*

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

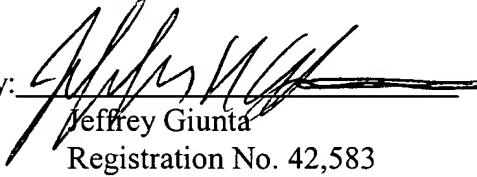
Sir:

Transmitted herewith is Amended Appeal Brief to the Board of Patent Appeals and Interferences from the decision dated March 10, 2005, of the Examiner finally rejecting claims 1-33 of the above-referenced application.

The Commissioner is hereby authorized to charge payment of any necessary fees associated with this communication, or credit any overpayment, to Deposit Account No. 09-0452.

Respectfully submitted,

Date: November 28, 2005

By: 
Jeffrey Giunta
Registration No. 42,583

FLEIT, KAIN, GIBBONS,
GUTMAN, BONGINI & BIANCO P.L.
One Boca Commerce Center
551 Northwest 77th Street, Suite 111
Boca Raton, Florida 33487
Telephone: (561) 989-9811
Facsimile: (561) 989-9812



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Jennie CHING et al.)
Serial No.: 09/412,969)
Group Art Unit: 2611)
Filed: October 5, 1999)
Examiner: Jason J. CHUNG)
For: DYNAMIC COMPOSITION)
AT THE SET-TOP BOX)

AMENDED APPEAL BRIEF

MS – APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appellants' Amended Brief is filed in response to a Final Office Action dated March 10, 2005, an Advisory Action dated May 19, 2005, a Notice of Appeal filed June 10, 2005, and a Notification of Non-Compliant Appeal Brief dated October 28, 2005. Reconsideration of the Application, withdrawal of the rejections and allowance of the claims are respectfully requested.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patent, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

ON: Nov 28, 2005 BY: JEFFREY N. GIUNTA
DATE

A handwritten signature in black ink, appearing to read "Jeffrey N. Giunta".

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines (IBM) of Armonk, NY.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-33 are pending.

Claims 1 through 33 are rejected.

The Appellants are appealing the rejection of independent claims 1, 11, 18 and 28. Claims 1, 11, 18, and 28 are on appeal.

IV. STATUS OF AMENDMENTS

The Examiner issued a final rejection of claims 1-33 in the Final Office Action of March 10, 2005. Appellants submitted a response with amendment to this Final Office action which amended the independent claims to correct minor grammatical errors and therefore place the claims into better condition for appeal. The Advisory Action dated May 19, 2005 addressed the Appellants' remarks, but did not indicate if these amendments were entered. The Appellants are assuming that these amendments were not entered for purposes of this appeal.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

This summary references line numbers of the specification as filed. It is to be noted that the text of each page of the filed specification starts with line number 5.

As set forth by the independent claims on appeal, the claimed subject matter includes a receiver for receiving a play-list and program content from a program provider. FIG. 5A, reference 43; FIG. 5B, reference 55, 57; specification page 13, lines 1-2 and 22-23, page 14, lines 7-9. The play-list (FIG. 3, reference

300) is a list of instructions (FIG. 3, reference 310) for the rendering of one or more multimedia segments into a multimedia presentation. FIG. 3, reference 310; specification page 10, line 22-29. The play-list is based on a user's demographics assembled by the program provider. Specification page 8, lines 9-30. The play-list (FIG. 3, reference 300) also contains pointers (FIG. 3, reference 302) to indicate where each of the multimedia segments selected from a group of primary media sources is located. Specification page 10, lines 17-22. The play-list (FIG. 3, reference 300) also contains a multimedia segment availability time (FIG. 3, reference 312) when the multimedia segment in the play-list (FIG. 3, reference 300) is to be received prior to the time the multimedia segment is to be rendered (FIG. 3, references 304 and 306). FIG. 3, references 304, 306 and 312; specification page 10, line 22 through page 11, line 2.

The claimed subject matter further includes a receiver for receiving the multimedia segments from the program provider. FIG. 5A, reference 43; FIG. 5B, reference 57; specification page 13, lines 1-2 and page 14, lines 7-9.

The claimed subject matter also includes means for determining (FIG. 5A, reference 41, FIG. 5B, reference 51) if all the multimedia segments required by the play-list (FIG. 3, reference 300) have been received according to the multimedia segment availability time. FIG. 5A, reference 41, FIG. 5B, reference 51, specification page 14, lines 19-24; FIG. 6, step 610, specification page 13, lines 28-30. The means for determining further, in response to one or more multimedia segments not being so received, requests one or more missing multimedia segments from a secondary media source different than the primary media source from which the multimedia segments were previously requested but not received. FIG. 4, reference 43; FIG. 6, step 612, specification page 13, line 30 through page 14, line 3; specification page 14, lines 24-28. The secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium. Specification page 14, lines 1-3 and lines 24-28.

The claimed subject matter also includes a means for rendering the multimedia segments into a multimedia presentation as directed by the play-list

(FIG. 3, reference 300). FIG. 5B, reference 58, specification page 13, lines 3-11; FIG. 6, step 620, specification page 14, lines 11-13.

The claimed subject matter also includes an interface to a display for displaying said multimedia presentation. FIG. 5A, reference 40, specification page 12, lines 10-13.

In addition to the above, the claimed subject matter includes breaking program content into a plurality of multimedia segments. FIG. 7, step 706, specification page 16, lines 24-27; specification page 8, lines 16-30. The claimed subject matter further includes transmitting at least one play-list (FIG. 3, reference 300) and program content to at least one client (FIG. 1, reference 4-7 and 9). FIG. 1, reference 4-7 and 9, specification page 7, lines 19-25; FIG. 7, steps 708 and 712, specification page 16, lines 24-30. The play-list (FIG. 3, reference 300) is a list of instructions for the rendering of one or more multimedia segments into a multimedia presentation and is based on a user's demographics assembled by the program provider. Specification page 8, lines 9-30. The play-list (FIG. 3, reference 300) contains pointers (FIG. 3, reference 302) to indicate where each of the multimedia segments selected from a group of primary media sources is located. Specification page 10, lines 17-22. The play-list (FIG. 3, reference 300) contains a multimedia segment availability time (FIG. 3, reference 312) when the multimedia segment in the play-list (FIG. 3, reference 300) is to be received prior to the time the multimedia segment is to be rendered (FIG. 3, reference 304, 306). FIG. 3, references 304, 306 and 312; specification page 10, line 22 through page 11, line 2.

The claimed subject matter further includes transmitting the multimedia segments required by said play-lists that form the multimedia presentation. FIG. 7, steps 708 and 712; specification page 16, line 24-30.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 11, 18 and 28 are unpatentable under 35 U.S.C. §103(a) over *Picco* (U. S. Patent No. 6,029,045) in view of *Zigmond* (U.S. Patent No. 6,571,392).

VII. ARGUMENT

A. WHETHER CLAIMS 1, 11, 18 AND 28 ARE UNPATENTABLE OVER *PICCO* IN VIEW OF *ZIGMOND*

In the Examiner's Office Action of March 10, 2005, the Examiner rejected claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over *Picco* (U. S. Patent No. 6,029,045) (Hereinafter *Picco*) in view of *Zigmond* (U.S. Patent No. 6,571,392) (hereinafter *Zigmond*). The Appellants respectfully submit that claims 1-33 are patentable over *Picco* and *Zigmond* under 35 U.S.C. § 103(a). The Appellants assert that neither the *Picco* nor the *Zigmond* references, taken either alone or in combination with one another, teach or suggest the claimed limitations, particularly when considering the invention "as a whole," of "receiving a play-list and program content from a program provider" as is set forth for the group I claims, i.e., "wherein the play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located" and "wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered."

Appellants respectfully suggest selection of independent claim 1 as representative of the independent claims on appeal. Independent claim 1 is directed towards a method for displaying on a viewer information processing system with an interface to a display, a set of multimedia segments to form a multimedia presentation, the method comprises the steps of:

receiving a play-list and program content from a program provider, wherein the play-list is a list of instructions for the

rendering of one or more multimedia segments into a multimedia presentation;

wherein the play-list is based on a user's demographics assembled by the program provider;

wherein the play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located;

wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered; and

receiving from the program provider the multimedia segments required by the play-list;

determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source different than the primary media source from which the multimedia segments were previously requested but not received, wherein the secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium; and

displaying the multimedia presentation on the display by rendering the multimedia segments as directed by the play-list.

The Appellants assert that, in particular, the underlined portions of the above claims are not taught or suggested by the *Picco* or *Zigmond* references, taken either alone or in combination with one another. These limitations with underlining highlighting the particular characteristics that are discussed below:

wherein the play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located;

wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered;

...
determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source

different than the primary media source from which the multimedia segments were previously requested but not received, wherein the secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium

The claims were rejected under 35 U.S.C. §103(a). The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter “as a whole,” and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention “as a whole.” As discussed below, the Appellants assert that these limitations, especially when considered in the context of the other limitations of claim 1, are not described in the prior art references of record and that these limitations render the claimed subject matter unobvious over the prior art.

Overview of Prior Art

To begin, the *Picco* reference is directed to a system and method for inserting local content into programming content. The system of *Picco* receives local content and selectively stores that local content based upon preferences that are also received. *Picco*, Column 13, lines 36-63. The system of *Picco* then receives programming data that is displayed to the user. This programming is able to include an indication of local content space. Upon encountering this local content space in the programming data, the system inserts stored local content data into this local content space. *Picco*, Column 14, lines 1-14.

The *Zigmond* reference is directed to receiving information from the internet if the information is not received from a broadcast channel. In the system of *Zigmond*, television video is broadcast along with an information resource, such as a web page, encoded therein. This information resource includes a resource identifier by which the information resource is identified. The television receiver of *Zigmond* stores the information resource and allows accessing the stored information resource by use of the resource identifier. The video broadcast of *Zigmond* then transmits a “trigger” that includes a resource identifier that instructs the television receiver to use the information resource

identified by the resource identifier to augment the video. *Zigmond*, Column 7, line 55 through column 8, line 30.

The Appellants point out that the *Zigmond* reference is directed towards displaying an information resource “along with television video in a synchronized fashion.” *Zigmond*, Abstract. The data displayed in the *Zigmond* system augments the video being displayed. *Zigmond*, Column 8, lines 26-30.

With further regards to the *Zigmond* reference, the *Zigmond* reference does teach that an “announcement” of a broadcast of an information resource that is to be transmitted may contain a time code to indicate the time at which that information resource is to be transmitted. *Zigmond*, Column 7, lines 57-61. The *Zigmond* reference, however, never teaches, mentions, or suggests a play list that contains a time when the information resource is to be received, as is set forth for the presently claimed invention. The lack of a teaching of this limitation of the presently claimed invention is particularly clear in the context of a subsequent limitation of the presently claimed invention, which specifies “determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source.”

Cited References Fail to Describe All Limitations

With regards to the third limitation of claim 1, the Appellants traverse the Examiner’s assertion that the *Picco* reference discloses that play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located. The Examiner cites *Picco*, column 8, lines 11-22 and column 6, line 57-column 7, line 32. The cited portions of the *Picco* reference are limited to broadcasting “local content” to receivers that may contain information identifying that local content, and transmitting “control signals” that describe the “type” of local content to insert. The *Picco* teachings therefore insert local content into programming based upon a matching of the “type” indicator included in the local content to the “type” specified by the control

signals. The teachings of the *Picco* reference perform this matching either by only storing local content that matches the specified type, or by storing several “types” of local content and retrieving the proper “type” when called upon to insert local content. In addition to the processing described above, the *Picco* reference further teaches that local content is able to include command and control data that specifies when and how to insert that particular local content. The Examiner repeats this assertion in the advisory action dated May 19, 2005, which asserts “which type of local content to insert, which inherently has to point to where the data is stored.” Advisory Action, continuation of item 11, first paragraph.

The Appellants respectfully assert that the “type” matching performed by the processing described by the *Picco* reference is not a teaching of “pointers” as is recited for independent claims 1, 11, 18 and 28. Claim 1 specifies: “wherein the play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located.” The Appellants respectfully assert that no data in the *Picco* reference indicates “where each of the multimedia segments ... is located,” but rather only a “type” description or identification of the data is used to select data from data which is already stored.

In particular, the Appellants respectfully assert that the teachings of the *Picco* reference include selecting a set of “local content” to broadcast to all receiving stations and also sending “control signals” to the “set-top box” at each receiving station. These control signals indicate which sub-set of the broadcast set of local content is to be stored by the set-top box. *Picco*, column 7, lines 30-41. These “control signals,” or content profiles, “may contain a bitstream of coefficients that indicate, for example, the interest of the household.” *Picco*, column 7, lines 48-53. *Picco* further teaches that the content broadcast to each household is able to have a “distribution variable” that indicates which households will store, and therefore have available for playback, the particular piece of local content. *Picco*, column 7, line 61 through column 8, line 6. The private data, which is intended for a particular receiver, is also able to contain command and control data to instruct how that particular private data is to be inserted into the satellite data stream. *Picco*, column 8, lines 37-39.

The *Picco* reference further describes that command and control data may be downloaded in real-time with a programming data stream so that the set-top box may determine which local content to insert into a video and at what time to insert that local content into the video. *Picco*, column 9, line 65 through column 10, line 4. *Picco* further teaches that programming data can have “local content space” into which “local content” can be inserted. The local content space is also able to include control data that indicates which type of local content may be inserted in that particular local content space. *Picco*, column 8, lines 16-22, emphasis added.

The Appellants respectfully assert that such control signals that identify a “type” of local content to insert into programming data falls far short of a teaching or suggestion of “pointers to indicate where each of the multimedia segments ... is located.” The teachings of *Picco* requires searching of the stored local content to find stored local content that is of the specified “type.” *Picco* requires additional processing over the “pointers” that are recited for claim 1 of the present invention.

Further, as discussed in more detail below, the Appellants further assert that the combination of the “resource identifiers” of the *Zigmond* reference with the teachings of *Picco* is improper.

With regards to the fourth clause of claim 1, the Appellants further respectfully traverse the Examiner’s assertion that *Picco* discloses “the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered.” Office Action dated March 10, 2005, page 4, third paragraph, internal citations omitted. The Examiner cites *Picco*, column 9, lines 10-13 and 40-43. The first cited portion of *Picco* refers to a graph in the drawings, i.e., FIG. 6 that illustrates the percentage utilization of a satellite channel for the transmission of “programming data” and indicates that the unused capacity is able to be used to transmit “private data.” The Appellants assert that this fails to teach or suggest “a multimedia segment availability time when the multimedia segment in the play-list is to be received prior” as is suggested by the Examiner. Office Action, page

4, third paragraph. The Appellants point out that this "availability time" is specified in this very limitation as being contained in the "play list."

The second portion of *Picco* that is cited with regards to the fourth clause of claim 1 states "the local content is downloaded before insertion for viewing by the user." *Picco*, column 9, lines 41-43. The Appellants respectfully assert that the teachings of *Picco* in this regard are limited to this circumstantial observation that follows from the operation of the *Picco* system. The *Picco* system operates by receiving and storing "local content" and then inserting elements of this stored content. *Picco*, column 6, lines 23-40. This necessarily limits the inserted segments to those which are already received. This observation is repeated in the Advisory Action dated May 19, 2005, continuation of item 11, second paragraph.

The Appellants respectfully assert that the teachings of *Picco* do not describe a "play-list" as is set forth by claim 1, especially when that claim is considered "as a whole." Claim 1 describes characteristics of the play-list that include "wherein the play list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered." The Appellants assert that construction of the term "multimedia segment availability time" should consider the description of sixth element of claim 1, which recites:

determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source

The Appellants assert that in the context of the above claim language, the "multimedia segment availability time" specifies a time before which the multimedia segments are received. The teachings of *Picco* do not include specifying any time by which a particular element of local content is to be received. The set-top box of *Picco* simply inserts local content that has been already received and stored by the set top box. The system of *Picco* therefore

does not specify that a particular item of local content to be stored. The system of *Picco* simply uses content that is already stored. As discussed above, the *Picco* reference does not teach or suggest a play-list which identifies particular multimedia segments, and therefore cannot specify a time by which such particular segments should be received. This characteristic of *Picco* is in contrast to the presently claimed invention, especially when the claims are considered “as a whole,” whereby a play-list is received and that play-list “contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located,” and “wherein the play-list contains a multimedia segment availability time” as is set forth in the independent claims for the presently claimed invention.

The Appellants further assert that the *Zigmond* reference does not teach or suggest a time by which an “information resource” is required to be received. The *Zigmond* reference teaches that the use of an information resource is triggered by a signal contained in the video stream. By way of analogy, the teachings of the *Zigmond* reference can be described as containing a “trigger” that indicates to use an information resource “now.” This is not applicable to a “multimedia segment availability time,” particularly one that is contained within a play-list as defined for claim 1.

Furthermore, as the cited references do not teach a “multimedia segment availability time,” the Appellants respectfully assert that the suggestion for this element can not come from the Applicant’s own specification. The Federal Circuit has repeatedly warned against using the Applicant’s disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The references of *Picco* and/or *Zigmond* do not even suggest, teach or mention this type of multimedia segment availability time.

The Appellants respectfully traverse the Examiner’s assertion that *Picco* teaches the claim limitation of “receiving from the program provider the

multimedia segments required by the play-list." Office Action dated March 8, 2005, page 4. paragraph 4. The cited portions of *Picco* teach deciding which elements of "local content" are to be inserted based upon the "local content" that is available at the uplink facility. *Picco*, column 6, line 57- column 7, line 32. In particular, *Picco* states "based on the various information, the schedule then determines the local content that is going to be transmitted by the satellite." *Picco*, column 7, lines 29-32. The Appellants respectfully assert that the *Picco* reference is limited to selecting local content to insert from that which is stored at the uplink facility. This is in stark contrast to receiving segments "required by the play-list" as is recited by the independent claims. This difference is even more apparent when considering the other limitations of claim 1, such as "determining if all the multimedia segments required by the play-list have been received...." The teachings of *Picco*, which generally describe the type of local content, cannot be extended to a system where there is a determination that all of the multimedia segments have been received.

In the Examiner's analysis of the *Picco* reference, the order of defining the play-list and receiving the content is reversed from that of the presently claimed invention. The Appellants therefore respectfully assert that such a reverse ordering would cause a modification of the *Picco* reference to the presently claimed invention would yield an inoperable system. Since *Picco* selects content to insert from content that is already received, the system of *Picco* cannot receive information "required by the play-list." If references taken in combination would produce a "seemingly inoperative device," such references have been held to teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness. *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

Furthermore, the differences between the Examiner's asserted teaching by *Picco* of receiving segments "required by the play-list" and the presently

claimed invention are even more apparent when considering the other limitations of claim 1, such as the limitation that specifies “determining if all the multimedia segments required by the play-list have been received....” The teachings of *Picco*, which generally describe the type of local content, cannot be extended to a system where there is a determination that all of the multimedia segments have been received. In considering claim 1 “as a whole,” the Appellants assert that the *Picco* and *Zigmond* references, taken either alone or in combination with one another, do not teach or suggest this aspect of the presently claimed invention.

With regards to the sixth clause of claim 1, the Appellants respectfully assert that the Examiner has not cited teachings for the complete contents of that limitation. The Examiner states that the combination of *Picco* and *Zigmond* discloses “in response to one or more removable medium.” Office Action dated March 10, 2005, page 4, last paragraph. The Appellants respectfully point out that this sixth clause includes more than the portion indicated by the Examiner. In particular, the sixth clause begins by reciting: “determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time.” The Appellants respectfully assert that this text is to be afforded patentable weight since it is at the beginning of the limitation, and is important when considering the claimed invention “as a whole.” The Appellants respectfully assert, for reasons similar to those discussed above, that this portion of the sixth limitation is not taught or suggested by cited references since the cited references do not teach or suggest “a multimedia segment availability time” that is “when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered.” The cited references further do not teach or suggest “a multimedia segment availability time” that is contained within a received “play-list” as is set forth in the independent claims when they are considered “as a whole.”

Combination of the Cited References is Improper

As an initial matter, the Appellants assert that the teachings of *Picco*, which are directed towards inserting stored local content into programming

content, cannot be properly combined with the teachings of *Zigmond*, which is directed towards a system of displaying an information resource along with television video in a synchronized fashion in order to augment the video. The Appellants assert that combining the video insertion system of *Picco* with the display augmentation system of *Zigmond* would yield an inoperable system.

The Appellants assert that the combination of the “resource identifier” of the *Zigmond* reference cannot be properly combined with the teachings of the *Picco* reference. The display of an information resource in the *Zigmond* reference is “triggered” by transmitting a “resource identifier” at the time that the information resource is to be used. *Zigmond*, Column 7, lines 18 through 34. The control signals of *Picco* only describe the type of data to insert. *Picco*, column 8, lines 7-22. The teachings of *Picco* do not teach or suggest providing a specific “list” of, for example, video segments to insert into programming data. The combination of the “general” descriptions of *Picco* with specific resource identifiers of *Zigmond* would yield an inoperable system.

If references taken in combination would produce a “seemingly inoperative device,” such references have been held to *teach away* from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness. *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references *teach away* from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

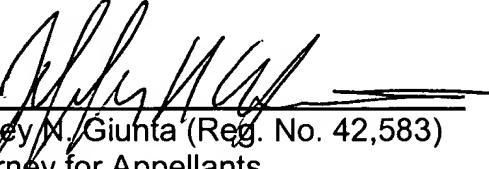
The Appellants respectfully assert that independent claims 11, 18 and 28 include similar limitations as those described above with regards to independent claim 1. Accordingly, independent claims 1, 11, 18, and 28 distinguish over *Picco* and/or *Zigmond* for at least the same reasons. Claims 2-10, 12-17, 19-27, and 29-33 depend from claims 1, 11, 18, and 28 respectively. Since dependent claims contain all the limitations of the independent claims, claims 2-10, 12-17, 19-27, and 29-33 distinguish over *Picco* and/or *Zigmond*, as well. Therefore, the rejection of claims 1-33 should be reversed.

CONCLUSION

For the reasons stated above, Appellants respectfully contend that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully submitted,

Dated: November 28, 2005

By: 
Jeffrey N. Giunta (Reg. No. 42,583)
Attorney for Appellants

Fleit, Kain, Gibbons, Gutman & Bongini
One Boca Commerce Center, Suite 111
551 N.W. 77th Street
Boca Raton, FL 33487
Tel. (561) 989-9811
Fax (561) 989-9812

VIII. CLAIMS APPENDIX

1. A method for displaying on a viewer information processing system with an interface to a display, a set of multimedia segments to form a multimedia presentation, the method comprising the steps of:

receiving a play-list and program content from a program provider, wherein the play-list is a list of instructions for the rendering of one or more multimedia segments into a multimedia presentation;

wherein the play-list is based on a user's demographics assembled by the program provider;

wherein the play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located;

wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered; and

receiving from the program provider the multimedia segments required by the play-list;

determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source different than the primary media source from which the multimedia segments were previously requested but not received, wherein the secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium; and

displaying the multimedia presentation on the display by rendering the multimedia segments as directed by the play-list.

2. The method of claim 1 wherein the step of receiving the multimedia segments includes storing at least one multimedia segment.

3. The method for displaying according to claim 1, wherein the step of receiving the multimedia segments includes receiving at least one multimedia segment over a broadcast infrastructure.
4. The method for displaying according to claim 1, wherein the step of receiving the multimedia segments includes receiving at least one multimedia segment from a computer readable storage medium.
5. The method for displaying according to claim 1, wherein the step of receiving the multimedia segments includes receiving at least one multimedia segment over a telecommunications network.
6. The method for displaying according to claim 5, wherein the step of receiving at least one multimedia segment over a telecommunications network includes receiving at least one multimedia segment over the Internet.
7. The method for displaying according to claim 1, further comprising the step of:
displaying the multimedia segments from the information processing system on a television set.
8. The method for displaying according to claim 1, wherein the step of receiving the multimedia segments includes receiving at least one multimedia segment which is an advertisement.
9. The method for displaying according to claim 1, wherein the step of receiving the multimedia segments includes receiving at least one multimedia segment which is program content.
10. The method for displaying according to claim 1, wherein the step of receiving a play-list includes receiving a play-list with a date when the multimedia segment is to be rendered.

11. A method for distributing program content from a program provider over a telecommunications infrastructure to a plurality of clients capable of receiving program content broken into a plurality of multimedia segments forming a multimedia presentation, the method on a program provider comprising the steps of:

breaking program content into a plurality of multimedia segments;

transmitting at least one play-list and program content to at least one client, wherein the play-list is a list of instructions for the rendering of one or more multimedia segments into a multimedia presentation;

wherein the play-list is based on a user's demographics assembled by the program provider;

wherein the play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located;

wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered; and

determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source different than the primary media source from which the multimedia segments were previously requested but not received, wherein the secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium; and

transmitting the multimedia segments required by said play-lists that form the multimedia presentation.

12. The method of claim 11, where the program provider transmits at least one multimedia segment to at least one client prior to the multimedia presentation by the client.

13. The method of claim 11, further comprising the step of:

grouping one or more clients receiving a play-list based on the demographics of the viewers of the multimedia presentation; and

wherein the step of transmitting at least one play-list includes transmitting the identical play-list to one or more clients based on the grouping.

14. The method of claim 11 for distributing program content, wherein the step of transmitting multimedia segments includes transmitting at least one multimedia segment on a computer readable storage medium.

15. The method of claim 11 for distributing program content wherein the step of transmitting at least one multimedia segment includes transmitting at least one multimedia segment over a cable network.

16. The method of claim 11 for distributing program content, wherein the step of transmitting the multimedia segments includes transmitting at least one multimedia segment over a telecommunications network.

17. The method of claim 16, for distributing program content wherein the step of transmitting at least one multimedia segment over a telecommunications network includes transmitting at least one multimedia segment on the Internet.

18. A computer readable medium comprising programming instructions for displaying on a viewer information processing system with an interface to a display, a set of multimedia segments to form a multimedia presentation, the programming instructions comprising

receiving a play-list and program content from a program provider, wherein the play-list is a list of instructions for the rendering of one or more multimedia segments into a multimedia presentation;

wherein the play-list is based on a user's demographics assembled by the program provider;

wherein the play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located;

wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered; and

receiving from the program provider the multimedia segments required by the play-list;

determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source different than the primary media source from which the multimedia segments were previously requested but not received, wherein the secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium; and

displaying the multimedia presentation on the display by rendering the multimedia segments as directed by the play-list.

19. The computer readable medium of claim 18, wherein said programming instruction includes receiving at least one multimedia segment prior to the presentation being displayed, and storing at least one multimedia segment.

20. The computer readable medium according to claim 18, wherein the programming instruction of receiving the multimedia segments includes receiving at least one multimedia segment over a broadcast infrastructure.

21. The computer readable medium according to claim 18, wherein the programming instruction of receiving the multimedia segments includes receiving at least one multimedia segment from a computer readable storage medium.

22. The computer readable medium according to claim 18, wherein the programming instruction of receiving multimedia segments includes receiving at least one multimedia segment over a telecommunications network.
23. The computer readable medium according to claim 22, wherein the programming instruction of receiving at least one multimedia segment over a telecommunications network includes receiving at least one multimedia segment over the Internet.
24. The computer readable medium according to claim 18, wherein the programming instruction of displaying includes displaying the multimedia segments from the information processing system on a television set.
25. The computer readable medium according to claim 18, wherein the programming instruction of receiving multimedia segments includes receiving at least one multimedia segment of an advertisement.
26. The computer readable medium according to claim 18, wherein the programming instruction of receiving multimedia segments includes receiving at least one multimedia segment of program content.
27. The computer readable medium according to claim 18, wherein the programming instruction of receiving a play-list includes receiving a play-list with a date when the multimedia segment is to be rendered.
28. A viewer information processing system with an interface to a display, for receiving a set of multimedia segments to form a multimedia presentation, the viewer information system comprising
 - a receiver for receiving a play-list and program content from a program provider wherein the play-list is a list of instructions for the rendering of one or more multimedia segments into a multimedia presentation;

wherein the play-list is based on a user's demographics assembled by the program provider;

wherein the play-list contains pointers to indicate where each of the multimedia segments selected from a group of primary media sources is located;

wherein the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior to the time the multimedia segment is to be rendered; and

a receiver for receiving the multimedia segments from the program provider;

means for determining if all the multimedia segments required by the play-list have been received according to the multimedia segment availability time and in response to one or more multimedia segments not being so received, then requesting one or more missing multimedia segments from a secondary media source different than the primary media source from which the multimedia segments were previously requested but not received, wherein the secondary media source is selected from the group of secondary media sources consisting of a second broadcast channel, internet, and removable computer readable medium;

a means for rendering the multimedia segments into a multimedia presentation as directed by the play-list; and

an interface to a display for displaying said multimedia presentation.

29. The viewer information processing system of claim 28, further comprising an interface to storage for storing at least one multimedia segment.

30. The viewer information processing system according to claim 28, wherein the receiver has an interface to a broadcast infrastructure.

31. The viewer information processing system according to claim 28, wherein the receiver has an interface to a computer readable storage medium.

32. The viewer information processing system according to claim 28, wherein the receiver has an interface to a telecommunications network.

33. The viewer information processing system according to claim 32, wherein the receiver interface to a telecommunications network includes an interface to the Internet.

IX. EVIDENCE APPENDIX

NONE

X. RELATED PROCEEDINGS APPENDIX

NONE